

Application No. 10/750,402  
Amendment dated January 26, 2005  
Reply to Office Action of November 2, 2004

**REMARKS**

Claims 1-45 and 47-51 are presented for Examiner Chapman's consideration.

Claim 1 has been amended to add the negative limitation, "wherein the disposable garment does not include an absorbent assembly." This amendment is supported throughout the specification and particularly in figures 1-8 and the descriptions thereof. This amendment is allowable under M.P.E.P. 2173.05(i) which states that "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." In the current specification at page 19, line 8, the present invention states that the garment "may also include an absorbent assembly 150." Therefore, Applicants have explicitly excluded this element from claim 1.

Claim 46 has been canceled.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

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### **Response to Rejections**

By way of the Office Action mailed 11/02/2004, claims 1, 2, 5, 7-10, 12, 14, 15, 17, 24-26, 28, 30, 31, 33-35, 38, 40-43, 45, 47, 48, 50 and 51 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 referencing *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Also, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131 (citing *Richardson*, 868 F.2d at 1236 (Fed. Cir. 1989)).

As to claim 1 and those claims depending therefrom, Applicants have amended claim 1 to include the limitation "wherein the disposable garment does not include an absorbent assembly." *Allen* neither expressly nor inherently describes a disposable garment that does not include an absorbent assembly and therefore fails to anticipate Applicants' currently amended claim 1. Therefore, Applicants respectfully request that this rejection be withdrawn. Likewise, claims 2, 5, 7-10, 12, 14, 15 and 17 depend from claim 1 and are patentable for at least the same reason.

As to claims 24-26, 28, 30, 31, and 33, Applicants note that each of these claims depends from independent claim 19 which has not been rejected under *Allen*. Therefore, these claims are not anticipated for at least the same reason(s) as claim 19. Applicants respectfully request that the rejection to these claims be withdrawn.

As to claim 34, *Allen* does not teach each and every element either expressly or inherently. Specifically *Allen* does not teach "an absorbent assembly positioned between

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the outer layer and the elastic inner layer, wherein the absorbent assembly includes a topsheet layer, core layer and a barrier layer" as required by Applicants' claim 34. The Examiner has not provided a citation to *Allen* teaching an absorbent assembly with the elements required by Applicants' claim. Therefore, Applicants respectfully request that the rejection to claim 34, and claim 35 depending therefrom, be withdrawn.

By way of the Office Action mailed 11/02/2004, claims 3, 4, 19-23, 36 and 37 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*) in view of U.S. Patent Number 4,756,709 to Stevens (*Stevens*). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2142, 2143.

Claims 3 and 4 depend from currently amended claim 1. Claim 1 includes the limitation "wherein the disposable garment does not include an absorbent assembly", as discussed above. Neither *Allen* nor *Stevens*, alone or in combination, teach or suggest a disposable garment that does not include an absorbent assembly. Therefore, a *prima facie* case of obviousness has not been established as regarding claims 3 and 4 and Applicants respectfully request the rejection be withdrawn.

As to claims 19-23, the Examiner acknowledges that *Allen* fails to address a stretchable outer layer. The Examiner relies on Figures 14 and 19 of *Stevens* for an outercover that "is resiliently stretchable in the longitudinal and lateral directions (71, 73) and laterally extensible (80, 82)... ." Even assuming this to be correct, *arguendo*, the

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Examiner has not shown that *Allen* or *Stevens*, alone or in combination, have an elastic inner layer having an elastic inner layer retraction value and a stretchable outer layer having a stretchable outer layer retraction value that is less than the elastic inner layer retraction value as required by Applicants' claim 19. Therefore, no *prima facie* case of obviousness has been established. Claims 20-23 depend from claim 19 and are non-obvious for at least the same reason. Applicants respectfully request that the rejection be withdrawn.

As to claims 36 and 37, which depend from claim 34, the Examiner acknowledges that *Allen* fails to address a stretchable outer layer. The Examiner looks to *Stevens* for the stretchable outer layer. However, no *prima facie* case of obviousness has been established because there is no suggestion or motivation to modify the references or combine reference teachings. To the contrary, adding the outer cover of *Stevens* to the article of *Allen* would frustrate one of the purposes of *Allen*, i.e., to create a void space between the topsheet and the absorbent core. *Allen* states at column 13, lines 1-6, "ideally the longitudinally contracted and foreshortened topsheet 12' will generally conform to the wearer, while the larger radius of curvature of the absorbent core 18' allows the core 18' to fall away from the topsheet 12' and create the void space 28' thereinbetween." Whereas, *Stevens* provides a resiliently stretchable outer cover to provide a "**form-fitting**, anatomically self-adjusting disposable diaper that **conforms** to the baby's shape." (col. 3; 48-52, emphasis added). If the outer cover of *Stevens* provides a conforming fit, one skilled in the art would not, therefore, be motivated to add the outer cover of *Stevens* to the article of *Allen* because doing so would frustrate the object of *Allen*, to create a void space. Therefore, no *prima facie* case of obviousness has been established and Applicants respectfully request this rejection be withdrawn.

**By way of the Office Action mailed 11/02/2004, claims 6, 11, 13, 18, 27, 29, 39, 44 and 46 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S.**

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**Patent Number 5,037,416 to Allen *et al.* (Allen) in view of U.S. Patent Number 5,817,086 to Kling (Kling). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.**

Claims 6, 11, and 13 depend from currently amended claim 1. Claim 1 includes the limitation "wherein the disposable garment does not include an absorbent assembly", as discussed above. Neither *Allen* nor *Kling*, alone or in combination, teach or suggest a disposable garment that does not include an absorbent assembly. Therefore, a *prima facie* case of obviousness has not been established as regarding claims 6, 11 and 13 and Applicants respectfully request the rejection be withdrawn.

As to claim 18, neither *Allen* nor *Kling*, alone or in combination, teach or suggest all the claim limitations set forth in Applicants' claim. Specifically, *Allen* does not teach an "elastic inner layer perimeter [being] bonded to the outer layer perimeter with a plurality of ultrasonic bonds" as required by Applicants' claim 18. The Examiner cites column 4, lines 51-52 and states, "the inner and outer layers may be at least partially joined at their perimeters using ultrasonic, heat/pressure or adhesive in a variety of bonding patterns." Applicants respectfully disagree with the Examiners reading of *Allen*. *Allen* states, "The **elastic members** may be adhesively joined to the backsheet, ultrasonically bonded, or heat/pressure sealed using a variety of bonding patterns." (*Allen* at col. 4, lines 51-53, emphasis added). The citation does NOT teach bonding the elastic inner layer perimeter to the outer layer perimeter with a plurality of ultrasonic bonds. The addition of *Kling* does not cure this defect. Therefore, neither *Allen* nor *Kling*, alone or in combination, teaches or suggests all the claim limitations of Applicants' claim 18. For at least this reason, the rejection should be withdrawn.

As to claims 27 and 29, which depend from independent claim 19, the Examiner previously acknowledged that *Allen* fails to address a stretchable outer layer. Neither *Allen* nor *Kling*, alone or in combination, teach or suggest a stretchable outer layer as set forth in Applicants claim 19. Therefore, no *prima facie* case of obviousness has been established.

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Claims 27 and 29 depend from claim 19 and are non-obvious for at least the same reason. Applicants respectfully request that the rejection be withdrawn. Even if the Examiner looks to *Stevens* for the stretchable outer cover, the Examiner has failed to provide any suggestion or motivation to modify or combine *Allen*, *Kling*, and *Stevens*.

As to claims 39, neither *Allen* nor *Kling*, alone or in combination, teach or suggest all the claim limitations set forth in Applicants' claim. The Examiner acknowledges that *Allen* fails to teach the use of liquid permeable outer layer as required by claim 39. The Examiner looks to **one layer** of the outer layer laminate of *Kling* to find a liquid permeable outer layer. Applicants respectfully disagree with this line of reasoning. The outer layer of *Kling* is NOT liquid permeable regardless of whether one layer of the laminate is permeable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness. Applicants respectfully request that this rejection be withdrawn.

As to claim 44, the Examiner acknowledges that *Allen* fails to teach the use of liquid impermeable inner layers. However, the Examiner asserts that it would have been obvious to construct the inner layer and opening of *Allen* with a liquid impermeable material as taught by *Kling* to provide a dry skin-contacting surface to the wearer to reduce skin irritation. The Examiner has provided no citation to either *Allen* or *Kling* evidencing the motivation or suggestion to make the combination. *Allen* specifically teaches the opposite, namely, the topsheet is liquid pervious to permit liquids to readily penetrate through. (col. 6: 16-18). *Kling* discusses a liquid-impermeable topsheet **in conjunction** with the specific embodiment illustrated in Figs. 5 and 6. In that embodiment, there is a large front opening 431 through which urine is to pass, thus allowing the topsheet to be liquid-impermeable. However, *Allen* specifically teaches that, "the size of the passageway 21" is a balance between the **minimum** size necessary to accommodate variations in the placement of the anus relative to the perineum and various cross-sections of solid fecal material, while minimizing undue skin contact with such waste materials." (col. 12: 33-38, emphasis added). Therefore, one skilled in the art would not be motivated to take the liquid-impermeability feature of *Kling*, that is acceptable because of the large front opening, and

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construct the inner layer and opening of *Allen*, which tries to minimize the size of the opening. Therefore, there is no *prima facie* case of obviousness established and Applicants request that this rejection be withdrawn.

Claim 46 has been cancelled, rendering the rejection as to this claim moot.

By way of the Office Action mailed 11/02/2004, claims 16, 32 and 49 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to *Allen et al. (Allen)* in view of U.S. Patent Number 5,269,775 to *Freeland et al. (Freeland)*. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

Claim 16 depends from currently amended claim 1. Claim 1 includes the limitation "wherein the disposable garment does not include an absorbent assembly", as discussed above. Neither *Allen* nor *Freeland*, alone or in combination, teach or suggest a disposable garment that does not include an absorbent assembly. Therefore, a *prima facie* case of obviousness has not been established as regarding claim 16 and Applicants respectfully request the rejection be withdrawn.

As to claim 32, which depends from independent claim 19, the Examiner previously acknowledged that *Allen* fails to address a stretchable outer layer. Neither *Allen* nor *Freeland*, alone or in combination, teach or suggest a stretchable outer layer as set forth in Applicants claim 19. Therefore, no *prima facie* case of obviousness has been established. Claim 32 depends from claim 19 and is non-obvious for at least the same reason. Applicants respectfully request that the rejection be withdrawn. Even if the Examiner looks to *Stevens* for the stretchable outer cover, the Examiner has failed to provide any suggestion or motivation to modify or combine *Allen*, *Freeland*, and *Stevens*.

As to claim 49, there is no suggestion or motivation in *Allen* or *Freeland*, alone or in combination, to modify or combine. The Examiner asserts that it "would therefore be obvious [to one] having ordinary skill in the art at the time the invention was made to

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construct the garment of Allen with an outer layer having a greater width in the lateral direction as taught by Freeland to provide a more comfortable fit to the wearer while the garment is in use." Applicants respectfully disagree. The Examiner has provided no citation in either reference to suggest that one would be motivated to combine the teachings of Freeland with Allen. The Examiner has stated the purported motivation, i.e., "to provide a more comfortable fit." However, Allen has already provided a solution to a more comfortable fit, that is, to provide a topsheet that has a low contact force. There is no teaching in *Allen* to suggest that an outer layer having a greater width in the lateral direction would provide a more comfortable fit. Likewise, *Freeland* appears to teach foreshortening of the topsheet relative to the backsheet to create a void therebetween. This teaching does not relate to comfort. Even the fact that the references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggest the desirability of the modification or combination. M.P.E.P. § 2142, 2143. Therefore, the Examiner has not made a *prima facie* case of obviousness and the Applicants respectfully request this rejection be withdrawn.

For the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

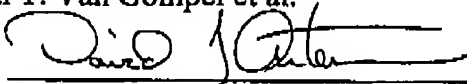
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The undersigned may be reached at: (920) 721-3016.

Respectfully submitted,

Paul T. Van Gompel et al.

By



David J. Arteman

Registration No.: 44,512

Attorney for Applicant(s)